UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,722	12/02/2003	Kwan Hang Kang	U 014918-9	4310

			EXAMINER
7590	06/21/2006		AIRAPETIAN, MILA

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ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/725,722	KANG ET AL.
	Examiner	Art Unit	
	Mila Airapetian	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 December 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the claim 5 recites the following limitation in line 12: "computes the optimum Cycle Per Minute of a corresponding user", which is confusing. Claims 1 and 5 include a term "tall" which is confusing. For the purpose of examination Examiner interprets the term "tall" as "height".

Claim 1 line 6 includes the following phrase: "in accordance with a control the user", which appears to be misspelled.

Claims 1, 2, and 5 includes the phrase "such as", which renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 1 and 5, the phrase "etc." renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by

"etc."), thereby rendering the scope of the claim(s) unascertainable. See MPEP
§ 2173.05(d).

Claims 1 and 5 include the following term: "weight". It is not clear which weight is
considered, a weight of a club head, or a user.

Claim 5 recites the limitation "a basic information data" twice: in line 4 and line 7,
which is confusing.

Furthermore, claim 5 recites the limitation "the basic information items" in line 9.
There is insufficient antecedent basis for this limitation in the claim.

Furthermore, claim 5 recites the limitation "by the brands" in line 14. There is
insufficient antecedent basis for this limitation in the claim.

Claim 7 recites "a step in which after the relationship of the CPM with respect to
each basic information is computed, the optimum CPM computation unit of the server
computer provides different weights by the basic information items based on a
correlation between each basic information item and the optimum CPM" which is vague
and confusing. It is not clear what does the phrase "relationship of the CPM with respect
to each basic information inputted" actually contemplates.

Preliminary Note.

Examiner understands the phrase "such as age, tall, weight, grasping power,
career, flying distance by the clubs, swing speed" as: "the at least one of: age, tall,
weight, grasping power, career, flying distance by the clubs, swing speed".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng (US 5,722,899) in view of Solheim (US 2002/0077956).

Claim 5. Cheng teaches a method for making a matched set of golf clubs

utilizing frequency conversion values, wherein the optimum weighted frequency (in

cycles per minute (CPM) is determined based on a desired club head weight inputted

for a selected shaft and a desired vibration frequency selected for a user, and wherein

said optimum weighted CPM is computed by comparing with basic (initial) weighted

CPM computed for randomly selected shafts (col. 2, lines 15-45; col. 3, lines 40-64).

However, Cheng does not specifically teach that said CPM is calculated using

basic information including at least one of age, tall, weight, grasping power, career,

flying distance by the clubs or swing speed inputted by the user.

Solheim teaches a method for selling golf clubs wherein the manufacturer's

server provides an estimate as to whether the clubs can be fitted to the user using basic

information such as the user's height and other pertinent information [0006].

Furthermore, Solheim teaches:

(1) a step in which a member connection of a user computer that connected with a server computer through a communication network is performed, and a certain form data is outputted to a corresponding user computer for inputting a basic information data used for computing the optimum CPM (Cycle Per Minute) in accordance with an optimum CPM computation request of the user computer [0016];

(2) a step in which when a basic information data such as age, tall, weight, grasping power, career, flying distance by the clubs, swing speed, etc. is inputted from the user computer, the server computer provides different weights by the basic information items in accordance with a correlation between each basic information item and the optimum CPM based on the CPM data with respect to each previously stored basic information and computes the optimum CPM of a corresponding user [0016];

(3) a step in which the server computer extracts, from the golf club database, a product list by the brands proper to the optimum CPM of a corresponding user computed based on the basic information data inputted from the user computer and outputs to a corresponding computer [0016]; and

(4) a step in which when a purchase data of a specific golf club is inputted from the user computer that received the product list by the brands proper to the optimum CPM, the server computer requests a cost payment and performs the cost payment based on the golf club purchase based on the cost payment data inputted from the user computer and controls an operation that the golf club is delivered to the address that a

corresponding user inputted ([0016], [0019], providing shipping information indicates delivery of the purchased items).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cheng to include the computation steps as disclosed in Solheim, because it would advantageously allow to provide a user with a golf club having certain club characteristics including vibration frequency optimized for the selected club (Cheng; col. 1, lines 7-12, 38-45).

Claim 7. Cheng teaches said method, wherein the optimum weighted frequency (in cycles per minute (CPM) is determined based on a desired club head weight inputted for a selected shaft and a desired vibration frequency selected for a user, and wherein said optimum weighted CPM is computed by comparing with basic (initial) weighted CPM computed for randomly selected shafts (col. 2, lines 15-45; col. 3, lines 40-64).

Solheim teaches said method, including the sub-steps of:

(2-1) a step in which the server computer judges whether a basic information data is inputted from the user computer for computing the optimum CPM [0016];

(2-2) a step in which as a result of the judgment, when a basic information data is inputted from the user computer for computing the optimum CPM, the server computer stores a basic information data for computing the optimum CPM inputted from the user computer into the member management database [0016];

(2-3) a step in which the optimum CPM computation unit of the server computer computes a relationship of the CPM with respect to each basic information inputted from the user computer based on the CPM data with respect to each basic information stored in the CPM database [0016];

(2-5) a step in which the optimum CPM computation unit of the server computer computes the optimum CPM of a corresponding user based on different weights by the basic information item provided in the step (2-4);

(2-6) a step in which the server computer stores the optimum CPM of a corresponding user computed by the optimum CPM computation unit and outputs to a corresponding user computer, so that the user can check the optimum CPM proper to the user [0016].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cheng to include the computation steps as disclosed in Solheim, because it would advantageously allow to provide a user with a golf club having certain club characteristics including vibration frequency optimized for the selected club (Cheng; col. 1, lines 7-12, 38-45).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Cheng and Solheim, as applied to claim 5, in view of Kim et al. (US 2001/0011235).

Claim 6. Cheng and Solheim teaches said method wherein said step (1) includes the sub-steps of:

(1-1) a step in which the server computer requests a member log-in or new member registration to the user computer that is connected with the server computer through the communication network (Fig. 2);

(1-6) a step in which the server computer judges whether an optimum CPM computation request data is inputted from the user computer that performed the member connection [0016]; and

(1-7) a step in which as a result of the judgment, when an optimum CPM computation request data is inputted from the user computer, the server computer outputs a certain form data to a corresponding user computer for inputting a basic information data for an optimum CPM computation [0016].

However Cheng and Solheim does not teach:

(1-2) a step in which the server computer judges whether a member log-in data is inputted from the user computer or a new member registration selection data is inputted from the user computer;

(1-3) a step in which as a result of the judgment, when a member log-in data is inputted from the user computer, the inputted data is compared with a log-in data of a corresponding user stored in the member management database, so that a member connection is performed;

(1-4) a step in which as a result of the step 1-2, when a new member registration

selection data is inputted from the user computer, the server computer outputs a certain

form data for a new member registration to a corresponding user computer;

(1-5) a step for storing a log-in information and personal information inputted by

the user in accordance with a certain form data into the member management

database, performing a new member registration process and requesting a

reconnection.

Kim et al. (hereinafter Kim) teaches a method of analyzing customer information

wherein the system judges whether the logged-in user is a regular member, or a new

user. In case if the user is a non-member, the web server proceeds with a new member

registration to store the member registration data to the user inputs [0042], [0144],

[0145].

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Cheng and Solheim to include a feature of checking if the

logged-in user is a regular member, or a new user, and in case if a non-member, the

web server proceeds with a new member registration to store the member registration

data to the user inputs, as disclosed in Kim, because it would advantageously allow to

use provided data for optimizing golf club characteristics for said new users.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable

over the combination of Cheng and Solheim, in view of Williams (US

2002/0049508).

Claim 8. Cheng and Solheim teaches said method wherein said step (3) includes the sub-steps of:

(3-1) a step in which the server computer extracts a product list by in a permissible error range of the optimum CPM of a corresponding user computed in the step (2) among the product lists by each brand stored in the golf club database [0016];

(3-2) a step in which the server computer classifies the product lists extracted in the step (3-1) in a sequence most proper to the optimum CPM of a corresponding user [0016];

(3-3) a step in which the server computer generates a diagnosis data of a golf club proper to a corresponding user based on the optimum CPM of a corresponding user computed in the step (2) [0016]; and

(3-4) a step in which the server computer outputs the product list classified in a sequence most proper to the optimum CPM of a corresponding user in the step (3-2) and the diagnosis data generated in the step (3-3) to a corresponding user computer, respectively [0016].

However, Cheng and Solheim does not teach that said golf clubs are classified by the brands.

Williams teaches a method for providing a virtual match of golf wherein the user may view an on-line catalog for particular brand golf clubs [0100].

The motivation to combine Cheng, Solheim and Williams would be to offer variety

of products to the customer.

Claim 9. Cheng and Soheim teaches said method wherein said step (4) includes

the sub-steps of:

(4-1) a step in which the server computer judges whether a purchase data of a

specific golf club is inputted from the user computer that received the product list proper

to the optimum CPM [0016];

(4-2) a step in which as a result of the judgment, when a purchase data of the

golf club is inputted, the cost payment unit of the server computer outputs a cost

payment request data for paying the specific golf club selected by the user to the user

computer [0019];

(4-3) a step in which the server computer judges whether a cost payment data is

inputted from the user computer based on the purchase of the specific golf club [0019];

(4-4) a step in which as a result of the judgment, when the cost payment data is

inputted from the user computer based on the purchase of the specific golf club, the

cost payment unit of the server computer processes a payment of the cost through a

payment method selected by the user [0019];

(4-5) a step in which the server computer generates a delivery data for delivering

the specific golf club selected by the user to the address that the user inputted, after the

user pays the cost through the payment method selected by the user [0019];

(4-6) a step in which the server computer outputs the delivery data generated in the step 4-5 to the server that manages the delivery [0019]; and

(4-7) a step in which the server computer checks the completion of the delivery of the golf club purchased by the user and finishes the service [0019].

However, Cheng and Solheim does not teach that said golf clubs are classified by the brands.

Williams teaches a method for providing a virtual match of golf wherein the user may view an on-line catalog for particular brand golf clubs [0100].

The motivation to combine Cheng, Solheim and Williams would be to offer variety of products to the customer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US 2002/0004723 to Meifu discloses a golf data management system, data center, and method of managing golf data.

(ii) US 2003/0008731 to Anderson discloses an automated method and system for golf club selection based on swing type.
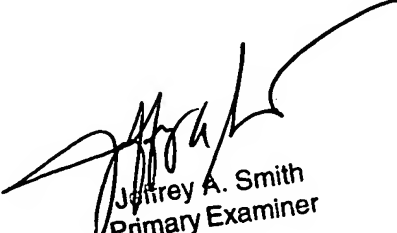
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeff Smith can be reached on (571)272-6763. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

Jeffrey A. Smith
Primary Examiner